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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 85804-014508	
I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to Examiner Leslie Wong, Art Unit 2164, United States Patent and Trademark Office, Facsimile No.: (571) 273-8300. on <u>March 2, 2006</u> Signature <u>Suzanne Marx</u> Typed or printed name <u>Suzanne Marx</u>		Application Number 09/848,982	Filed May 3, 2001
		First Named Inventor Ted E. Dunning	
		Art Unit 2164	Examiner Leslie Wong
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,000</u> <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Carole A. Quinn Typed or printed name (714) 708-6500 Telephone number March 2, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> Total of <u>-3-</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1460, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Ted E. Dunning and Bradley D. Kinnig	Examiner:	Leslie Wong
Serial No.:	09/848,982	Group Art Unit:	2167
Filed:	May 3, 2001	Docket No.:	85804-014508
Title:	TEXT EQUIVALENCING ENGINE		
Customer No.:	32361		

CERTIFICATE UNDER 37 CFR 1.6(d)

I hereby certify that this correspondence and identified enclosures are being transmitted via facsimile only to Examiner Leslie Wong, Art Unit 2167, United States Patent and Trademark Office, Facsimile No. (571) 273-8300 on March 2, 2006.


Name: Suzanne Marx

LETTER SUBMITTING REMARKS WITH
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Date: March 2, 2006

MAIL STOP AF
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This paper is being filed with a Request For Pre-Appeal Brief Review and a Notice of Appeal.

Applicants seek formal review by a panel of examiners of the claim rejections raised in an Office Action mailed December 2, 2005 (hereinafter referred to as the "Office Action"). By the Office Action, at least one claim stands twice rejected. Accordingly, appeal of the rejection, and request for pre-appeal brief review are timely and proper. More particularly, Applicants request review of the 35 U.S.C. § 103(a) rejection of Claims 1 to 35. The remarks made herein supplement Applicants' remarks of record in the instant case.

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Claims 1 to 35 stand rejected under 35 U.S.C. § 103(a) over U.S. Pat. No. 5,418,951 (Damashek) and U.S. Publ. No. 2002/0152204 (Ortega). Claims 1, 12, 23 and 34 are independent.

Claim 1 recites a method of text equivalencing from a query string of characters. According to the method, the query string is modified using a predetermined set of heuristics. A character-by-character comparison of the modified query string with at least one known string of characters in a corpus is performed in order to locate a match. In response to not finding an exact match, a plurality of sub-strings of characters are formed from the query string. The formed sub-strings have varying length such that at least two of the formed sub-strings differ in length. Further and in response to not finding an exact match, an information retrieval technique is used on the sub-strings formed from the query string to identify a known string of characters equivalent to the query string.

Thus, Claim 1 (as do independent Claims 12, 23 and 34) recites the features of forming, in response to not finding an exact match, a plurality of substrings of characters from a query string, the sub-strings having varying lengths such that at least two of the formed sub-strings differ in length, and using an information retrieval technique on the sub-strings formed from the query string to identify a known string of characters equivalent to the query string. Applicants' remarks presented in the Amendment After Final Rejection, which was filed concurrently with a Request For Continued Examination on August 11, 2005, pointed out that the applied art, namely Damashek and Ortega, is not seen to disclose or suggest at least these features.

While not conceding that the Damashek reference is not deficient in other areas, in addressing the presently stated grounds for rejections based on that reference, and as is described in Damashek at col. 5, lines 24 to 30, documents are parsed into *n-grams*, where *n* is a fixed value, such as *n* = "5". In addition, Figure 3 of Damashek shows formed *n-grams* which are all of length "2", i.e., *n* = "2". Thus, Damashek establishes a value of *n* such that all of the *n-grams* are of length *n*. Damashek fails to disclose forming substrings having varying lengths such that at least two of the formed substrings differ in length.

In the current Office Action, the Examiner states (at page 8):

"[t]he fact that [the, sic] Damashek discloses that N is any positive integer means that one can keep increasing N until the results prove useful. For example, if *n*=2 does not produce adequate letters for comparison, one can increase *n*=3 or greater if need be to allow the string to be compared to other strings in an efficient manner. Fig. 3 shows *n*-gram=2 and

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col. 5, lines 24-30 shows n -gram=5. At such, we would have 'at least two of the formed sub-string differ in length' as claimed." (Emphasis removed.)¹

As is clear from the cited portions of Damashek identified in the above-quoted portion of the Office Action, Damashek merely describes fixing the value of n to a certain value, and then using the fixed value of n to generate all of the n -grams, such that all of the n -grams are of length n . The Examiner seems to be taking the position that Damashek describes resetting n for some subset of the n -grams, such that one n -gram can differ in length from another n -gram. It is noteworthy that in the Action there is no reference to a specific portion of Damashek that provides support for this position, and indeed no such portion of Damashek can be found. It is clear, from the description found in Damashek, that regardless of what value is set for n , the value of n is fixed for all of the n -grams, such that all of them will be of length n , and that if n is reset to a different value, then all of the n -grams will still be of the same length, i.e., whatever the value fixed for n . Generating n -grams all having length n is clearly not the same as forming a plurality of substrings of characters from a query string, the substrings having varying lengths such that at least two of the formed substrings differ in length. Thus Damashek fails to teach or suggest the recited claim limitation of forming a plurality of substrings of characters from a query string, the substrings having varying lengths such that at least two of the formed substrings differ in length, and on this reason the reference, alone or in proposed combination with Ortega, fails to meet all of the claimed limitations of the pending claims. Indeed the Office Action concedes, and it is agreed, that Ortega fails to disclose or to suggest forming a plurality of substrings of characters from a query string, the sub-strings having varying lengths such that at least two of the formed sub-strings differ in length.

Moreover, and even while the above differences should be found sufficient to withdraw the § 103(a) rejection, the rejection is further deficient and should be withdrawn because nothing in either reference discloses or suggests forming the claimed substrings of varying length in response to not finding a match in a comparison of character strings. The n -grams, which the Examiner compares to the claimed substrings, are formed in Damashek without regard to whether or not a string comparison yielded a match. (See, e.g., Figures 1, 2, 10 and 11 of

¹ The Office Action then generally references, U.S. Patent No. 6,131,082 (Hargrave), and an excerpt purportedly taken from Wikipedia, and U.S. Publ. No. 2003/0190077 (Ross). The Office Action states that this new art is being introduced to "reinforce the point regarding varying [the] length of N as mentioned above". It is noted that these references do not form part of the grounds for rejection of the claims. In addition, the Examiner indicates that these references merely reiterate the points made concerning Damashek. Accordingly and with regard to these references, Applicants respectfully refer to Applicants' remarks concerning Damashek, made herein and in Applicants' previous remarks.

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Damashek). Based on the concessions made in the Office Action, and the reference itself, Ortega does not teach or suggest forming substrings of varying length in response to not finding a match in a comparison of character strings, and thus even were the references combined they fail to meet the claim limitations.

For at least the reasons set forth above, 35 U.S.C. § 103(a) should be withdrawn. Notwithstanding this and as further basis for withdrawal of the rejection, Applicants submit that there has not been a proper showing of a motivation or suggestion to make the hypothetical combination suggested in the Office Action. The Office Action contends that the hypothetical combination would have been obvious in order to:

“...facilitate processing and increasing the efficiency of a search query by invoking the spelling correction process to attempt to correct the non-matching term(s) and comparing a non-matching term of a search criteria with data in the correlation table to identify any possible replacements (§0010)...as suggested by Ortega et al. at ¶s 0054 and 0066.”

However, it is submitted that nothing in the cited portion of Ortega provides the stated suggestion or motivation for the proposed hypothetical combination. In addition and as pointed out in Applicants' remarks submitted with the Amendment dated September 17, 2004, Damashek is directed to identifying the language or topic of a document using n-grams. More particularly, Damashek parses a document to generate n-grams, which are then used to identify a commonality with n-grams of a reference document or language. Ortega, on the other hand, is directed to identifying spelling errors. There is no hint or suggestion of the hypothetical combination proposed in the Office Action, nor any evidence of record that the proposed improper combination meets all of the claimed limitations of the pending claims. In fact, it is unclear what (if any) practical value exists in the hypothetical combination, as proposed in the Office Action, which would perform spelling correction in a process that determines the language or subject of a document.

As is clearly set forth in In re McLaughlin, 443 F.2d 1392 (CCPA 1971) and progeny, the Examiner is limited to only that which was known to the person of ordinary skill at the pertinent time to which the rejection applies, and the Applicants' invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, “use that which the inventor has taught against its teacher” to provide the missing motivation to combine the references to yield the claimed invention. In re Lee, 277 F.3d 1338, 1344, citing W.L. Gore v. Garlock, Inc., 721

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F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999);

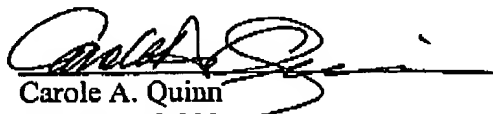
Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See e.g., C.R. Bard, Inc. v. M3 Sys., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion "essential" to avoid hindsight)...Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.")

Notwithstanding that the combination does not yield the claimed invention, it is submitted that Applicants' own disclosure is being used as a road map to make the hypothetical combination, which is clearly improper. Accordingly, it is submitted that a prima facie case of obviousness has not properly been made, and withdrawal of the 35 U.S.C. § 103 rejection of pending Claims 1 to 35 is therefore appropriate, and is respectfully requested.

No additional fee is believed to be necessary. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-2638, referencing the Attorney Docket Number when charging payments or credits.

Respectfully submitted,

Date: March 2, 2006



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